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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$ 330)

Complete if Known	
Application Number	09/605,544
Filing Date	June 29, 2000
First Named Inventor	Colin S. COL
Examiner Name	Anita Choudhary
Art Unit	2153
Attorney Docket No.	003797.86783
RECEIVED JUL 02 2004 Technology Center 2100	

#### METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money  Other  None  
Order

Deposit Account:

Deposit Account Number  
19-0733

Deposit Account Name  
Banner & Witcoff, LTD.

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) during the pendency of this application  
 Charge fee(s) indicated below, except for the filing fee  
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#### FEE CALCULATION

##### 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code	Fee (\$)	Fee (\$)
1001	2001	770	385
1002	2002	340	170
1003	2003	530	265
1004	2004	770	385
1005	2005	160	80
SUBTOTAL (1)		(\$ 0)	

##### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
	** = 0	X 0	= 0
Independent Claims	** = 0	X 0	= 0
Multiple Dependent	0	X 290	= 0

##### Large Entity

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code	Fee (\$)	Fee (\$)
1202	2202	18	9
1201	2201	86	43
1203	2203	290	145
1204	2204	86	43
1205	2205	18	9
SUBTOTAL (2)		(\$ 0)	

\*or number previously paid, if greater; For Reissues, see above

#### 3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code	Fee (\$)	Fee (\$)
1051	2051	130	65
1052	2052	50	25
1053	1053	130	130
1812	1812	2,520	2,520
1804	1804	920*	920*
1805	1805	1,840*	1,840*
1251	2251	110	55
1252	2252	420	210
1253	2253	950	475
1254	2254	1,480	740
1255	2255	2,010	1,005
1401	2401	330	165
1402	2402	330	165
1403	2403	290	145
1451	1451	1,510	1,510
1452	2452	110	55
1453	2453	1,330	665
1501	2501	1,330	665
1502	2502	480	240
1503	2503	640	320
1460	1460	130	130
1807	1807	50	50
1806	1806	180	180
8021	8021	40	40
1809	2809	770	385
1810	2810	770	385
1801	2801	770	385
1802	1802	900	900
Other fee (specify) _____			

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 330)

#### SUBMITTED BY

Name (Print/Type)	Jordan N. Bodner	Registration No. (Attorney/Agent)	42,338	Telephone	202-824-3000
Signature				Date	June 29, 2004

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/605,544
Filing Date	June 29, 2000
First Named Inventor	Colin S. COLE
Art Unit	2153
Examiner Name	Anita Choudhary
Attorney Docket Number	003797.86783

## ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
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Remarks

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jordan N. Bodner, Registration No. 42,338	
Signature		
Date	June 29, 2004	

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of: )

Colin S. Cole et al. )

Serial No.: 09/605,544 )

Filed: June 29, 2000 )

For: Method for Request and Response Direct Data )  
Transfer and Management of Content )  
Manifests )

) Group Art Unit: 2153

) Examiner: Anita Choudhary

) Attorney Docket No.: 003797.86783

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**APPEAL BRIEF**

JUL 02 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Technology Center 2100

Sir:

Pursuant to 37 C.F.R. § 1.192, Appellants submit their Appeal Brief, in triplicate, to the Board of Patent Appeals and Interferences in response to the final Office Action mailed January 29, 2004 (paper no. 13). Please charge any necessary fees in connection with this Appeal Brief to our Deposit Account No. 19-0733.

**REAL PARTY IN INTEREST**

The owner of the above-identified application, and the real party in interest, is Microsoft Corporation.

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**RELATED APPEALS AND INTERFERENCES**

None.

**STATUS OF CLAIMS**

Claims 1-10 and 12-22 are pending and are being appealed herein. The pending claims are shown in the attached Appendix. The final Office Action rejected the claims as follows:

- Claims 1, 6-10, 16, 17, 19, 20, and 22 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,122,372 to Hughes (“Hughes”).
- Claims 12-15 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,446,110 to Lection et al. (“Lection”).
- Claims 5, 18, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of Lection.
- Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of U.S. Patent No. 6,507,856 to Chen et al. (“Chen”).

**STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final Office Action.

## **SUMMARY OF INVENTION**

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 C.F.R. § 1.192(c)(5)), Appellants do not intend to limit the claims; all references to the specification and drawings are illustrative unless otherwise explicitly stated.

Aspects of the present invention provide a framework that allows for the efficient exchange of data between application programs, even when the application programs are operating on different operating system platforms. Specification, p. 2, lns. 12-14. A software envelope may be generated that contains a data file, and the envelope is transmitted to a destination location. Specification, p. 2, lns. 17-18. The envelope may be implemented, for example, using XML tags. Specification, p. 8, lns. 9-10; Figure 3. At the destination location, an object may be created from the data file with a plugin object. Specification, p. 2, lns. 18-20. The plugin object may be chosen to correspond to the same predetermined schema under which the data file was created. Specification, p. 2, lns. 16-20.

A particular data structure may further be used to implement such efficient data exchange. The data structure may include a first field containing address information, a second data field containing the identification of a predetermined schema, and a third data field containing a data file formatted in a markup language in accordance with the schema. Specification, p. 3, lns. 8-11. The data structure may further include a data field containing manifest information that indicates the type of information contained in the software envelope. Specification, p. 10, lns. 10-11; Figure 5.

**ISSUES PRESENTED ON APPEAL**

- A. Whether the Examiner's reliance on a "substantial steps" test in making an anticipation rejection under 35 U.S.C. § 102 is improper.
- B. Whether claims 1, 6-10, 16, 17, 19, 20, and 22 are patentable over Hughes.
- C. Whether claims 12-15 are patentable over Lection.
- D. Whether claims 5, 18, and 21 are patentable over Hughes in view of Lection.
- E. Whether claims 2-4 are patentable over Hughes in view of Chen.

**GROUPING OF CLAIMS**

In accordance with 37 C.F.R. § 1.192(c)(7), Appellants respectfully request that the claims not stand or fall together. Appellants request that the following groups of separately patentable claims be recognized:

GROUP I -- Independent claims 1 and 20, and dependent claims 2-10, 21, and 22.

GROUP II -- Independent claim 16, and dependent claims 17-19.

GROUP III -- Independent claim 12, and dependent claims 13-15.

Separate arguments for patentability for Groups I-III are provided.

## **ARGUMENT**

### **A. The Examiner’s Reliance on a “Substantial Steps” Test is Improper in Making an Anticipation Rejection Under 35 U.S.C. § 102**

In rejecting claims 1, 6-10, 16, 17, 19, 20, and 22 as being anticipated by Hughes under 35 U.S.C. § 102, the Examiner acknowledges that Hughes fails to teach or suggest all of the claimed features. In particular, Hughes does not teach or suggest that a plugin object creates an object from a data file as claimed. To overcome this deficiency of Hughes, the Examiner asserts that “Hughes may not use the word ‘creating’ a message object, however Hughes takes substantial steps for carrying out a means for creating a message object from an incoming encapsulated message.” Final Office Action, p. 2. The Examiner’s “substantial steps” standard has no legal basis and is wholly improper in supporting an anticipation rejection under 35 U.S.C. § 102. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Importantly, the Examiner does not (and cannot) acknowledge that Hughes expressly or inherently describes each and every element as claimed.

Moreover, the Examiner’s assertion that Hughes does not use the word “creating” is a red herring. While Appellants recognize that identity of terminology is not required for anticipation. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), Hughes’s deficiency goes well beyond differing vocabulary; the claim feature, the concept itself, is simply not taught or suggested by Hughes (as will be discussed in later sections of this argument). For at least this reason, it is

respectfully submitted that the rejection of claims 1, 6-10, 16, 17, 19, 20, and 22 is improper and should be withdrawn.

**B. Claims 1, 6-10, 16, 17, 19, 20, and 22 are Patentable Over Hughes**

Independent claim 1 is directed to a method for exchanging data between a source location and a destination location. The method of claim 1 includes the step of creating an object from a data file with a plugin object corresponding to a predetermined schema. The final Office Action alleges that this feature is found in col. 9, lns. 25-32 of Hughes, which discusses using template, protocol, and contract tags to interpret a message:

Next, encapsulated message 200 includes a template tag 204 that provides a template CNS ID, a protocol tag 205 that provides a protocol CNS ID, and a contract tag 206 provides a contract CNS ID. The purpose of the template, protocol, and contract CNS ID's is to verifiably identify the template, protocol, and contract which should be used to interpret the encapsulated message.

Thus, this portion of Hughes discloses using template, protocol, and contract tags to *interpret* a message, not to *create* anything, much less an object, from a data file. Nor does any other portion of Hughes teach or suggest creating an object from a data file with a plugin object corresponding to a predetermined schema, as recited in claim 1.

The final Office Action acknowledges this deficiency of Hughes, and attempts to overcome it by alleging that Hughes nevertheless “takes substantial steps for carrying out a means for creating a message object from an incoming encapsulated message.” Final Office Action, p. 2. As discussed

above, this “substantial steps” standard used by the Examiner is the *wrong legal standard* to apply when making an anticipation rejection under 35 U.S.C. § 102.

Moreover, neither the cited portion of Hughes, nor any other portion of Hughes, teaches or suggests the recited plugin object. The Examiner apparently attempts to compare the template tag, protocol tag, or contract tag with the claimed plugin object. However, these are merely identifying tags, not a plugin object as claimed.

For at least these reasons, Hughes by itself fails to anticipate claim 1, since Hughes does not teach or suggest creating an object from a data file with a plugin object corresponding to a predetermined schema, as required by claim 1. Moreover, the Examiner’s “substantial steps” is improper and does not cure the lack of anticipation by Hughes.

Independent claim 16 is directed to a method for creating data at a source location to transmit to a destination location. The claimed method includes the steps of generating a data file with a markup language in accordance with a predetermined schema; identifying a plugin object that creates an object from the data file; generating a software envelope containing the data file; and transmitting the software envelope to the destination location.

As previously discussed, the cited portion of Hughes discloses using template, protocol, and contract tags to *interpret* a message. The cited portion of Hughes does not teach or suggest *a plugin object that creates an object* from a data file, as plainly recited in claim 16. Nor does any other portion of Hughes teach or suggest this feature of claim 16.

As also previously discussed, the “substantial steps” standard used by the Examiner is wholly improper and inappropriate to an anticipation rejection under 35 U.S.C. § 102. Notably, the Examiner has failed to show that Hughes, by itself, teaches or suggests each and every one of the features recited in claim 16.

Moreover, neither the cited portion of Hughes, nor any other portion of Hughes, teaches or suggests the recited plugin object. The Examiner apparently attempts to compare the template tag, protocol tag, or contract tag with the claimed plugin object. However, these are merely identifying tags, not a plugin object as claimed. Indeed, none of the tags in Hughes *create* anything; they merely contain identifying data. Hughes, col. 9, lns. 25-32. In contrast, claim 16 requires identifying a plugin object *that creates an object* from the data file.

For at least these reasons, claim 16 is allowable over Hughes.

Independent claim 20 is also allowable over Hughes for at least similar reasons as discussed above with regard to claim 1, and further in view of the differing features recited therein.

Claims 6-10, 17, 19, and 22 are also allowable over Hughes for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein.

**C. Claims 12-15 are Patentable Over Lection**

Independent claim 12 is directed to a computer readable medium having stored thereon a data structure. The claimed data structure includes various data fields, including a data field containing a

data file formatted in a markup language in accordance with the schema, and a data field containing manifest information corresponding to information contained in the data file data field. Thus, claim 12 requires both a data file data field and a manifest information data field.

The Examiner asserts that Lection discloses both data fields as being part of a data type definition (DTD). Lection's DTD contains screen information and session information. Lection, col. 9, lns. 15-17. The screen information contains three sub-elements: content, interaction, and display sub-elements. Lection, col. 9, lns. 23-26.

The Examiner attempts to compare Lection's screen and session information with the claimed data file data field, and the sub-elements within the screen and session information with the claimed manifest information data field. However, the sub-elements of the screen and session information are *part of* the screen and session information. In other words, this portion of Lection simply discloses a screen and session information structure having content, where the content includes the sub-elements. Accordingly, Lection fails to teach or suggest *both* the claimed data field including a data file *and* the data field including manifest information corresponding to information contained in the data file, as claimed.

Even assuming for the sake of argument that the sub-elements of the screen and session information can be compared with the claimed manifest information data field, these sub-elements nevertheless do not include manifest information as claimed. Appellants' specification describes "manifest information," for example, at p. 10, ln. 10, to p. 11, ln. 10. An example of manifest

information is also shown in Fig. 5 of the specification. Manifest information may include, for example, a name of a document, a description of the document, a name of attachments, a description of the attachments, and an identification of the type of attachments. In contrast, referring to Lection's sub-elements, the content element includes information about the host screen fields including both text content and text attributes (field start position, length, protected or unprotected, and field text) Lection, col. 9, lns. 27-30. The interaction element specifies and inbound function key. Lection, col. 9, lns. 31-32. The display element stores the host-application-generated screen-display-related information, such as background and foreground color. Lection, col. 9, lns. 38-40. However, *none of these sub-elements provide manifest information* as claimed, such as the name of a document, the description of the document, the name of attachments, the description of the attachments, and the identification of the type of attachments.

For at least the above reasons, it is submitted that claim 12 is allowable over Lection.

Claims 13-15 depend from claim 12 and are also allowable for at least those reasons that claim 12 is allowable, and further in view of the additional features recited therein.

**D. Claims 5, 18, and 21 are Patentable Over Hughes in View of Lection**

Claims 5, 18, and 21 are allowable for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein. Moreover, the addition of Lection fails to cure the above-discussed deficiencies of Hughes. Accordingly, claims 5, 18, and 21 are also allowable over the proposed combination of Hughes and Lection.

**E. Claims 2-4 are Patentable over Hughes in View of Chen**

Claims 2-4 depend from claim 1 and are allowable for at least those reasons that claim 1 is allowable, and further in view of the additional features recited therein. Moreover, the addition of Chen fails to cure the above-discussed deficiencies of Hughes. Accordingly, claims 2-4 are also allowable over the proposed combination of Hughes and Chen.

**CONCLUSION**

For all of the foregoing reasons, Appellants respectfully submit that the final rejection of claims 1-10 and 12-22 is improper and should be reversed.

Respectfully submitted,

Dated: June 29, 2004

By:



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**APPENDIX**

**CLAIMS INVOLVED IN THE APPEAL**

1. A method for exchanging data between a source location and a destination location comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema;

generating a first software envelope containing the data file;

transmitting the software envelope to the destination location; and

creating an object from the data file with a plugin object corresponding to the predetermined schema.

2. The method of claim 1, further including the step of:

automatically generating a second software envelope from the information contained in the first software envelope.

3. The method of claim 2, wherein the first software envelope contains destination and source address information and

wherein the step of automatically generating a second envelope includes generating a second envelope having a destination address matching the source address of the first envelope.

4. The method of claim 2, wherein the first software envelope contains state information and

wherein the step of automatically generating a second envelope includes generating a second envelope having a destination address determined by the state information.

5. The method of claim 1, wherein the markup language comprises extensible markup language (XML).

6. The method of claim 1, wherein the markup language comprises standard generalized markup language (SGML).

7. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via electronic mail.

8. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via HTTP.

9. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via an intermediate server.

10. A computer readable medium having computer-executable instructions for performing the steps recited in claim 1.

11. (Cancelled).

12. A computer readable medium having stored thereon a data structure comprising:

- (a) a data field containing address information;
- (b) a data field containing the identification of a predetermined schema;
- (c) a data field containing a data file formatted in a markup language in accordance with the schema; and
- (d) a data field containing manifest information corresponding to the information contained in the data file data field.

13. The computer readable medium of claim 12, further including:

- (d) a data field containing state information.

14. The computer readable medium of claim 13, wherein the state information contains address information.

15. The computer readable medium of claim 12, wherein the address information contains an address for replying to a message.

16. A method for creating data at a source location to transmit to a destination location comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema;

identifying a plugin object that creates an object from the data file;

generating a software envelope containing the data file; and

transmitting the software envelope to the destination location.

17. The method of claim 16, wherein the step of generating a software envelope includes generating a software envelope containing the data file and the plugin object.

18. The method of claim 16, wherein the markup language comprises extensible markup language (XML).

19. The method of claim 16, wherein the markup language comprises standard generalized markup language (SGML).

20. A method for extracting data from a file transmitted from a source location comprising the steps of:

receiving a software envelope containing a data file marked up with a markup language in accordance with a predetermined schema; and

creating an object from the data file with a plugin object corresponding to the predetermined schema.

21. The method of claim 20, wherein the markup language comprises extensible markup language (XML).

22. The method of claim 20, wherein the markup language comprises standard generalized markup language (SGML).